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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,457

09/26/2006

Masao Ogawa

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EXAMINER

DURHAM, NATHAN E

ART UNIT

PAPER NUMBER

3765

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,457	<b>Applicant(s)</b> OGAWA ET AL.	
	<b>Examiner</b> NATHAN E. DURHAM	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/05/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1, 7 and 15 are objected to because of the following informalities:

Within line 1 of claim 1, the applicant recites "an embroidery machine comprising" and within line 5 of claim 1 the applicant recites "the machine being". Based on the applicant's specification and the depending claims the recitation "An embroidery machine" should be replaced with "A printable embroidery machine" and the recitation "the machine" should be replaced with the phrase "the printable embroidery machine".

Regarding claim 7, it appears that the claim is improperly dependent from claim 2 wherein it should be dependent from claim 6 in order to show sufficient antecedent basis for all the limitations within the claim.

Within lines 1-2 of claims 1 and 15, the applicant recites "'a sewing machine body sewable on workpiece cloth". How is a sewing machine body sewed on a workpiece cloth? The examiner suggests replacing "a sewing machine body sewable on workpiece cloth" with "a sewing machine body capable of sewing on workpiece cloth".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the applicant recites “a frame drive unit which has a mounting part detachably attached to the sewing machine body” (Line 3) and “the machine being characterized in that an ink-jet printer is detachably attached to the mounting part of the frame drive unit” (Lines 5-7). Dictionary.com defines "attached" as meaning "joined, connected or bound". The phrase "detachably attached" is interpreted as meaning connected with the ability to be disconnected. Therefore, how is the drive unit connected to both the sewing machine body and the ink-jet printer at the same point in time? Does the applicant mean that the drive unit is “detachably attachable” to both the sewing machine body and an ink-jet printer? If so, what structure allows the sewing machine body and ink-jet printer to be attached/detached from the mounting part of the drive unit? Furthermore, it is unclear what components of the applicant’s claim 1 are structure and what components are functional uses thereof because the applicant has failed to clearly define the claimed invention. Is the claim supposed to be a combination claim of the drive unit, a sewing machine body and an ink-jet printer or is the claim supposed to be a combination claim of only the drive unit and the sewing machine body? What is meant by the statement “the machine being characterized” (Lines 5-6)?

For the purpose of this Office Action, the mounting part of the frame drive unit is considered “detachably attached” to the sewing machine body while the mounting part of the frame drive unit is considered “detachably attachable” to an ink-jet printer. The applicant’s recitation, “the machine being characterized in that an ink-jet printer is detachably attached to the mounting part of the frame drive unit separated from the sewing machine body so that the workpiece cloth held on the cloth holding frame moved by the frame drive unit is printed by the printer” is considered functional language and therefore will not be given patentable weight. The mounting part of the drive unit only has to be capable of being detachably attached to an ink-jet printer.

Claims 2-14 are dependent from claim 1 and are therefore also rejected under 35 U.S.C. 112, second paragraph.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph for similar reasons as claim 1. Is the applicant claiming a frame drive unit that is capable of connecting to both a sewing machine body and an ink-jet printer or is the applicant claiming a combination of a frame drive unit, a sewing machine body and an ink-jet printer? If the applicant is claiming the latter, how is the mounting part of the frame drive unit detachably attached to both the sewing machine body and ink-jet printer at the same moment in time? For the purpose of this Office Action, claim 15 will be interpreted as claiming a frame drive unit that is capable of detachably attaching to both a sewing machine body and an ink-jet printer. Therefore, the mounting part of the drive unit only has to be capable of being attached to both a sewing machine body and an ink-jet printer.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by ITO et al (U.S. Patent 5,906,168).

ITO discloses a sewing machine body (M, 1), a cloth holding frame (50) which holds a workpiece cloth to be sewn and a drive unit (2; including elements 60 and 80) having a mounting part (35, 128). ITO discloses the mounting part of the frame drive unit detachably attached to the sewing machine body (Figures 5, 16, 17 and 19). ITO discloses the cloth holding frame being coupled to the drive unit wherein the cloth holding frame is moved independently in two horizontal directions perpendicular to each other (Figures 16 and 17). The drive unit is considered fully capable of detachably attaching to an ink-jet printer based on the detachably attachable features of the mounting part (Refer to 35 U.S.C. 112, second paragraph rejections above for claim interpretation purposes).

***Conclusion***

The prior art made of record, as cited on attached PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN E. DURHAM whose telephone number is (571)272-8642. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NED

/Gary L. Welch/  
Supervisory Patent Examiner, Art Unit 3765